

REMARKS

Claims 1-11 were pending prior to the present amendment. Claims 1 and 11 have been amended and claims 12-20 newly entered. Claims 1-20 are patentable for, at least, the reasons set forth herein.

REJECTIONS UNDER 35 U.S.C. 102(e)

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kato. Claim 1 is independent and claims 2-6 ultimately depend therefrom.

Kato is cited as teaching an amidine group linked together by macromolecular polyolefinic groups. The present invention clearly sets forth a discrete compound with a central nitrogen containing moiety and substituents thereon which are not polymeric. The Office has argued that the polymeric structure recited in Kato would read on R3 and R4 when these groups are aliphatic.

In an effort to advance the application to allowance claim 1 has been amended to recite specifically that R3 and R4 are not polyolefins. The rejection of claim 1, and all claims depending therefrom, under 35 U.S.C. 102(e) is rendered moot by amendment and withdrawal is respectfully requested.

The rejection of claims 1-6 under 35 U.S.C. 102(e) are overcome by amendment of claim 1.

REJECTIONS UNDER 35 U.S.C. 103

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerillo in view of Breton et al.

Zerillo is directed to a method for forming an ink jet image on a lithographic plate. Breton is directed to inks for use with electric field assisted acoustic ink jet printing on paper or transparencies.

The Office has argued that Zerillo does not teach that the fluid contains an oleophilizing compound having in its structure an amidine functional group capable of reacting with the surface of the lithographic plate. Applicant agrees with this position. The present invention is not taught by Zerillo.

Breton is cited as teaching an acoustic ink jet printing method and the inks for use therein. The purpose of the ink is clearly set forth in column 2, lines 29-44, wherein it is taught that the inks are specifically formulated for fusing to transparencies, crease resistance in plain and coated paper, minimization of paper curl by decreasing water, etc. It is clear that there is no intention of using these inks on a metal surface. Therefore, the ability, or lack thereof, of oleophilizing a metal surface is not even contemplated.

One of ordinary skill in the art would have no basis to extract a single compound from about 4 columns of disclosure in Breton to achieve a property which Breton does not address, discuss or even acknowledge. Even if one were to attempt the onerous task of trying compounds described in various publications Breton would not be chosen since this ink is describe to improve the final image on paper. This combination of Zerillo with a single compound buried in the description of Breton can only be made in hindsight and, even then, one of ordinary skill in the art would have no basis to expect this to be suitable for the presently claimed invention.

Applicants respectfully submit that the combination of Zerillo and Breton would only be made in hindsight based on the information provided in the present application. Even if this combination were made in hindsight one would not be expected to use a viscosity compound from ink specific to improve the properties of an image on paper as an oleophilizing compound on a metal surface. Nowhere in the cited art is there any teachings which would lead a skilled artisan to correlate the properties of imaged paper with the ability of a compound to act as an oleophilizing agent.

The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Zerillo in view of Breton et al. can

only be made in hindsight based on the teachings of the present application and is therefore improper. Removal of the rejection is respectfully requested.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerillo in view of Breton et al., as applied to claim 6, in further view of Arimatsu et al.

The inapplicability of the rejection of claim 6 based on Zerillo in view of Breton et al. is set forth above. The arguments are equally applicable herein.

The Office further argues that Arimatsu et al. provides the additional teachings that the hydrophilic support is aluminum. This is in conflict with Breton which is specifically detailed to have low water content to avoid water entering the paper based media.

If one combined Arimatsu et al. with Zerillo and Breton et al. they would either be expected to utilize paper, which is contrary to the teachings of Zerillo and Arimatsu, or metal, which is in conflict with the teachings of Breton. It is certainly not expected that a skilled artisan would arrive at the conclusion that one ingredient, taught as a viscosity compound in an acoustic ink for paper, would be incorporated into Zerillo and Arimitsu, which is specific to neither acoustic ink nor paper, to arrive at an ink with improved

oleophilizing properties. This combination can only be made in hindsight and is therefore improper.

Applicants respectfully submit that the rejection of claim 7 as being unpatentable over Zerillo in view of Breton et al., as applied to claim 6, in further view of Arimatsu et al. is improper and removal is respectfully requested.

Claims 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zerillo in view of Breton et al., as applied to claim 1, in further view of Toyama et al.

The inappropriateness of combining Zerillo and Breton is describe previously and the arguments apply here as well.

Toyama et al. is directed to an inorganic pigment in a binder comprising a high polymer compound and a synthetic high polymer latex.

The present invention specifically excludes polymers as set forth previously. The teachings of Toyama et al. are contrary to the claimed invention and a rejection based thereon is improper.

Applicants respectfully request that the rejection of claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Zerillo in view of Breton et al., as applied to claim 1, in further view of Toyama et al. be withdrawn.

ALLOWABLE SUBJECT MATTER

Claim 11 was objected to as being dependent on a rejected base claim. The objection has been rendered moot by the amendment of claim 11 to an independent claim with all of the limitations of the base claim from which it depended.

A notice of allowance for claim 11 is proper and respectfully requested.

NEWLY ENTERED CLAIMS

Claims 12-20 are newly entered patentable claims. Claim 12 is an independent claim drawing support from original claim 1 and the specification. Claims 13-20 ultimately depend from claim 12 and are supported by original claims 2-10.

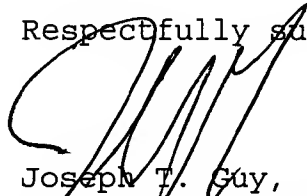
Claim 12 recites an oleophilizing compound wherein R3 and R4 are not an aliphatic group.

A notice of allowance for claims 12-20 is respectfully requested.

CONCLUSIONS

Claims 1-20 are pending in the present application. All claims are in condition for allowance and notice thereof is respectfully requested.

Respectfully submitted,



Joseph T. Guy, Ph.D.
Agent for Applicants
Registration Number 35,172
NEXSEN PRUET JACOBS & POLLARD, LLC
P.O. Box 10648
Greenville, SC 29603
Telephone: 864-370-2211
Facsimile: 864-282-1177

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